

**REMARKS**

**I. Status of Claims**

Claims 1-118 are currently pending. No claim has been amended herein.

**II. Rejections under 35 U.S.C. § 102(b)**

A. The Examiner has rejected claims 1-12, 14, 16, 32-34, 38-45, 47, 49-60, 62, 64, 65, 69-80, 82, 84-94, 96, 98-100, 103, 104-114, 116, and 118 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,085,859 to Halloran et al. ("Halloran"). According to the Examiner, Halloran teaches both polymethylsilsesquioxane and "various film formers." Office Action at 3.

The instant claims are directed towards a composition comprising both (a) at least one polymethylsilsesquioxane film former and (b) at least one film former different from said at least one polymethylsilsesquioxane film former. Halloran, to the contrary, teaches a single ingredient: "an interpenetrating polymer network which includes a nonpolar silsesquioxane and a substituted vinyl copolymer." Halloran, col. 9, ll. 1-5.

This interpenetrating polymer network "is an intimate combination of two polymers with each polymer being in network form. . . . This chemical and physical combination of two or more structurally dissimilar polymers often results in a modification of properties . . . ." *Id.* at col. 8, ll. 18-31. This is not merely a blend of two pre-formed polymers. See IUPAC definition of interpenetrating polymer network in Compendium of Chemical Terminology, page 205 (2d ed. 1997) (attached herewith as Exhibit 1).

In the presently claimed composition, the at least one polymethylsilsesquioxane film former and at least one film former different from said at least one

polymethylsilsesquioxane film former do not form an interpenetrating polymer network. Halloran nowhere teaches or suggests a composition comprising *two separate* film-forming ingredients. As the instant claims are directed towards a mixture of preformed polymers, and not an interpenetrating polymer network, Applicants respectfully request withdrawal of this rejection.

B. Claims 17-27, 29, and 31 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Halloran as evidenced by Harry's Cosmetology, pages 50 and 754. The Examiner relies on Harry's Cosmetology as teaching that "lotions are emulsions and emulsions can be either oil-in-water or water in oil . . . ." Office Action at 3. As discussed above, the Examiner has not established that Halloran anticipates the instant claims. Therefore, Applicants respectfully request withdrawal of this rejection.

C. Applicants additionally note that the Examiner has failed to consider all of the claim limitations. A claim is only anticipated if each and every element of that claim is taught by a prior art reference. M.P.E.P. § 2131. Halloran, however, fails to teach all of the elements in the instant claims, for example claims 32-70 and 86-118. Claims 32-50 are drawn towards a cosmetic foundation composition, claims 51-70 are drawn towards a mascara composition, claims 86-103 are drawn towards an eyeliner composition, and claims 104-118 are drawn towards a make-up composition for lips. Halloran deals solely with a hair fixative composition, and fails to mention any of cosmetic foundation, mascara, eyeliner, and make-up composition for the lips. Yet the Examiner ignores the claims' limitations of specific cosmetic products, stating only that "[t]he examiner[']s position is that all the claims are drawn to compositions and the intended use and the property does not carry any patentable weight." Office Action at 3.

This is improper. The M.P.E.P. directly instructs that “to anticipate a claim, the reference must teach **each and every element** of the claim.” M.P.E.P. § 2131 (emphasis added). Here, Halloran admittedly does not teach each and every element of claims 32-70 and 86-118. As the Examiner has failed to establish otherwise, Applicants respectfully request withdrawn of the rejection of claims 32-70 and 86-118.

**III. Rejection under 35 U.S.C. § 103**

Claims 1-66, 70-101, and 104-118 have been rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of Halloran, U.S. patent No. 5,756,082 to Cashin et al. (“Cashin”), and U.S. Patent No. 5,959,009 to Konik et al. (“Konik”). The Examiner states that “[t]he difference between the [Halloran] patent and the claims is the patent does not disclose the limitation of claims 36 and 37 with respect to the ranges and also to the limitation where in the percent of [the at least one polymethylsilsesquioxane film former] is higher than [the at least one film former different from said at least one polymethylsilsesquioxane film former] and the specific film formers claimed in claims 13, 28, 48[, ]63, 83, 97 and 115.” Office Action at 5.

While these deficiencies in the references have been recognized, the Examiner no where attempts to rectify them. It is no where established that either Cashin or Konik teaches or suggests a composition wherein the at least one polymethylsilsesquioxane film former is present in the composition in a higher amount than the amount of the at least one film former different from said at least one polymethylsilsesquioxane film former.

In fact, Halloran suggests the exact opposite. Neither Cashin nor Konik teach or suggest a polymethylsilsesquioxane at all, and Halloran, which does teach a

polymethylsilsesquioxane, suggests that the other film former component should be present in a higher concentration than the polymethylsilsesquioxane, and not vice versa. According to Halloran, “[t]he most preferred range of the two ingredients in the interpenetrating polymer network is one to five weight percent of nonpolar silsesquioxane and four to ten weight percentage of substituted vinyl copolymer.” Halloran, col. 10, ll. 17-21. Moreover, Table VI in Halloran, quantifying the weight percentages of nonpolar silsesquioxane and substituted vinyl copolymer in Examples XII-XXII, demonstrates that none of the Examples contain a higher amount of the silsesquioxane.

Therefore, one of ordinary skill in the art would not be motivated, from the teachings of Halloran, Cashin, and Konik, to form a composition wherein the at least one polymethylsilsesquioxane film former is present in the composition in a higher amount than the amount of the at least one film former different from said at least one polymethylsilsesquioxane film former. As the Examiner has failed to establish otherwise, Applicants respectfully request withdrawal of the rejection of claims 15, 30, 46, 61, 81, 95, and 117 on at least this ground.

The Examiner has also failed to establish a *prima facie* case of obvious as regards the other rejected claims, namely claims 13, 28, 35-37, 48, 63, 66, 83, 97, 100, and 115, wherein the at least one film former different from said at least one polymethylsilsesquioxane film former is chosen from specified copolymers or wherein the composition comprises additional ingredients. In order to establish such a *prima facie* case, the Examiner must demonstrate, among other things, some suggestion or motivation to combine reference teachings. M.P.E.P. § 2143. In the instant case, the

Examiner states, “[t]he motivation to use the film formers of [Cashin] in the composition stems from the teachings of the patent that this polymer along with oils and polymers provide the compositions having less residue when applied and excellent [a]esthetics and the film formers of [Konik] when added to the compositions of ‘849 along with oil (emollients), gellant (thickening agent) provide the compositions water proof or water resistant compositions.” Office Action at 6.

This “showing” is not sufficient. Halloran, for example, is directed towards a hair fixative composition. Cashin is primarily directed towards an antiperspirant or deodorant cosmetic stick, and Konik is directed towards a mascara waterproofing composition. In discussing the background of the invention, Halloran notes that a film-forming additive in a hair fixative composition should have certain properties specific to hair fixative compositions, such as, for example, curl retention, rapid drying, and easy removability upon shampooing. Halloran, col. 1, ll. 38-42. The Examiner has failed to explain why one of ordinary skill in the art, when formulating a hair fixative composition, would be motivated look to film forming agents used in waterproof mascaras and/or deodorant compositions.

For example, Halloran teaches the film forming agent should be easily removed during shampooing, yet such a characteristic may be undesirable in film forming agents used to formulate a waterproof mascara. This failure to explain any motivation to combine the references is particularly egregious given Halloran’s specific discussion regarding the drawbacks of other film forming additives. See Halloran, col. 1, l. 62 - col. 2, l. 11 (discussing disadvantages of known film forming agents, such as poor spray properties, clogging of valves, and poor hold). Indeed, after consideration of Halloran

as a whole, one of ordinary skill in the art would be led away from incorporating any film forming agent other than the substituted vinyl copolymer included in the interpenetrating polymer network.

Even assuming *arguendo* there were some suggestion or motivation to combine the film forming additives of Cashin and/or Konik into the composition of Halloran, there would still be no *prima facie* case of obviousness. As discussed above, Halloran is directed towards a specific interpenetrating polymer network including a substituted vinyl copolymer (film forming agent). No where does Halloran hint that any other film forming agent, outside of the specific substituted vinyl copolymer, could be used to form the interpenetrating polymer network around which the entire disclosure revolves. Therefore, no *prima facie* case of obviousness has been established, and the rejection should be withdrawn.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 27, 2004

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Erin C. DeCarlo  
Reg. No. 51,688

**Attachment:** Exhibit 1 - Compendium of Chemical Terminology, page 205 (2d ed. 1997)



### **Exhibit 1**

Compendium of Chemical Terminology, page 205 (2d ed. 1997)



International Union of Pure and Applied Chemistry

# Compendium of Chemical Terminology

IUPAC RECOMMENDATIONS

COMPILED BY ALAN D. McNAUGHT  
AND ANDREW WILKINSON

The Royal Society of Chemistry, Cambridge, UK

SECOND EDITION

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Blackwell

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return

internal standard (in chromatography)

intersystem crossing

**internal standard (in chromatography)**

A compound added to a sample in known concentration to facilitate the qualitative identification and/or quantitative determination of the sample components.

1993, 65, 837

**internal surface**

With respect to porous solids, the surface associated with pores communicating with the outside space. Since the accessibility of pores may depend on the size of the fluid molecules, the extent of the accessible internal surface may depend on the size of the molecules comprising the fluid, and may be different for the various components of a fluid mixture (*molecular sieve effect*).

1976, 46, 79; 1972, 31, 585

**internal transmittance**See *transmittance*.

1996, 68, 2248

**internal valence force field (IVFF)**

A force field expressed in terms of bond-stretching, angle-bending, torsional and other displacements directly connected to the structural parameters of the molecule:

$$V = \frac{1}{2} \sum k_{ij} (\text{or } K_{ij}) R_i R_j$$

where  $k$  (or  $K$ ) are the *force constants* and  $R$  the internal valence coordinates.

1978, 50, 1709

**international calorie**See *calorie*.

G.B. 112; 1996, 68, 976

**International system of units**See *SI*.

G.B. 69

**+ international unit**

The unit of enzyme activity proposed by the International Union of Biochemistry in 1964. Specifically, it is the amount of enzyme that catalyses the conversion of one micromole of substrate per minute under the specified conditions of the assay method.

Note:

This unit is no longer recommended because the term does not indicate what physical quantity it refers to, and because the minute is not the SI unit of time.

1994, 66, 2593

**interparticle porosity (in chromatography),  $\varepsilon$** 

The interparticle volume of a packed column per unit column volume:

$$\varepsilon = V_0/V_c$$

It is also called the *interstitial fraction* of the column.

1993, 65, 832

**interparticle volume of the column (in chromatography),  $V_0$** 

The volume occupied by the mobile phase between the particles in the packed section of a column. It is also called the *interstitial volume* or the *void volume*

particle volume is equal to the mobile-phase holdup volume ( $V_M$ ) in the ideal case, neglecting any extra-column volume. In gas chromatography, the symbol  $V_G$  may be used for the interparticle volume of the column. In the ideal case, neglecting any extra-column volume,  $V_G$  is equal to the corrected gas hold-up volume ( $V_M^p$ ).

$$V_G = V_M^p = V_M^j$$

**interpenetrating polymer network (IPN)**

A polymer comprising two or more *networks* which are at least partially interlaced on a molecular scale but not covalently bonded to each other and cannot be separated unless chemical bonds are broken.

A mixture of two or more preformed polymer networks is not an IPN.

1996, 68, 2305

**interphase**See *interfacial layer*.

1986, 58, 439; 1994, 66, 1673

**interphase transition**

A transition that occurs at boundaries between phases. Example:

The precipitation of second phases or the initiation of new phase growth at an interface.

1994, 66, 584

**interstitial fraction (in chromatography)**

The *interstitial volume* per unit volume of a packed column. Defined by:

$$\varepsilon_i = V_i/X$$

where  $V_i$  is the *interstitial volume* and  $X$  the *column volume*.

O.B. 100

**interstitial velocity (in chromatography)**

The linear velocity of the *mobile phase* inside a packed column calculated as the average over the entire cross section. This quantity can, under idealized conditions, be calculated from the equation:

$$u = F/\varepsilon_i$$

where  $F$  is the *nominal linear flow* and  $\varepsilon_i$  the *interstitial fraction*.

O.B. 102

**interstitial volume (in gas chromatography)**

The volume  $V_G$  of the column not occupied by the liquid phase and its solid support, or by the active solid. It does not include any volume external to the column, such as the volume of the sample injector or of the detector.

O.B. 99

**intersystem crossing**

A photophysical process. An isoenergetic radiationless transition between two electronic states having different multiplicities. It often results in a vibrationally excited molecular entity in the lower electronic state, which then usually deactivates to its lowest vibrational level.



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